

REMARKS/ARGUMENTS

Claims 1, 3, 7, 9, 11, 16, 18, and 19 have been objected due to a few informalities. Applicants have amended these claims in a manner suggested by the Examiner. In view of these amendments, it is believed that the objection of these claims may be withdrawn.

Applicants request reconsideration of the rejection of claims 1-17 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Applicants have amended the claims to remove the positively claiming a user and a representative. In view of the amendments to the claims it is believed that the rejection of claims 1-17 under 35 U.S.C. §101 may be withdrawn.

Applicants request reconsideration of the rejection of claims 1-8 under 35 U.S.C. §112, second paragraph, as being indefinite. Applicants have amended the claims to remove the limitation “once the telephone connection has been established”. Again, in view of the amendment to the claims, it is submitted that the rejection of claims 1-8 under 35 U.S.C. §112 may be withdrawn.

Applicants request reconsideration of the rejection of claims 1-4, 6-12, and 14-17 as being unpatentable under 35 U.S.C. §102(b) as being anticipated by D’Agostino, U.S. Patent No. 5,231,571. Applicants have amended claims 1 and 9, the base independent claims, to include the patentable feature of the controlling means comprising different levels of control. The D’Agostino reference does not disclose such a feature. Further, while the Examiner has indicated that D’Agostino discloses a computer 14, such computer 14 is not capable of being accessing the Internet as Applicants have claimed. The Examiner has not even indicated that the computer 14 is capable of accessing the Internet. In particular, computer 14 is a dedicated terminal that is connected only to

representative terminals 12 by telephone links 16 and data links 18. The disclosure of

D'Agostino states at Column 5, lines 11-20:

Moreover, **the customer terminal does not act like a computer.** It provides human contact with a knowledgeable representative who controls the customer terminal from the representative terminal and talks to the customer over a telephone. **The customer need only watch the display screen as he would watch a television screen,** while conversing with the representative over the telephone. Thus, **the representative controls the display on the screen rather than the customer controlling the display on the screen.** (emphasis added.)

Further, Applicants have also claimed a computer system capable of being accessed by the computer over the Internet. Again, the D'Agostino reference does not disclose a computer system capable of being accessed over the Internet. The Examiner has not even indicated that the computer 12 is capable of accessing the Internet. The customer terminal 14 and the representative terminal 12 are connected directly to each other in a dedicated arrangement.

Claims 2 and 10 have been amended to include the patentable feature of the computer having a web enabled program and one level of control is the controlling means controlling operation of the web enabled program. The D'Agostino reference does not disclose that the computer 14 has a web enabled program or one level of control is the controlling means controlling operation of the web enabled program. Claims 3 and 11 have been amended to depend from claims 2 and 10, respectively, and such claims now include the patentable feature of sending the quote to the web enabled program. Since the D'Agostino reference does not disclose that the computer 14 has a web enabled program then D'Agostino does not disclose sending the quote to the web enabled program.

Claims 4 and 12 have been amended to include the patentable feature of one level of control is the controlling means sending information from the computer system to the computer with information including an audio file, a video clip, or a slide show presentation. The D'Agostino reference does not disclose this feature.

The Examiner takes the position that the computer 14 is a hand held computer as Applicants have claimed in claims 6 and 14. However, a review of the D'Agostino reference clearly shows that the computer 14 is not a hand held computer. The customer terminal 14 includes a housing or booth 20. The housing 20 is large and is in no way a hand held computer as Applicants have claimed.

Claim 7 has been amended to include the patentable limitation of the computer system has a website and the computer has a web enabled program and one level of control is the controlling means controlling operation of the web enabled program to navigate about the web site. As has been pointed out previously, the D'Agostino reference does not disclose that the computer system 12 has a web site, the computer 14 has a web enabled program, or one level of control is the controlling means controlling operation of the web enabled program to navigate about the web site.

With reference now to claims 8 and 17, these claims have been amended to include the patentable feature of the first window and the second window being displayed simultaneously in the display. The D'Agostino reference only discloses that the screen which is displayed in the display 24 of the customer booth system 14 appears on the display 44 of the representative terminal 12. There is no disclosure of the display 44 of the representative terminal 12 being able to have two different windows displayed at the same time.

The Examiner has taken the position that the customer terminal 14 is a wireless hand held computer and the Examiner even suggests that Figure 2A shows no wires therefore this is a wireless connection. However, the Applicants note that there is no disclosure of the customer terminal 14 being wireless or being a hand held device. The disclosure of the D'Agostino reference clearly shows that the customer terminal 14 is wired to the representative terminals 12 by wired links 16 and 18. Further, as discussed above, the terminal 14 has a housing 20 that indicates that the terminal 14 is not a hand held device.

With respect to claim 16, Applicants have amended this claim to include the patentable features of the computer system has a website and the computer has a web enabled program and one level of control is the controlling means controlling operation of the web enabled program to navigate about the web site. As indicated previously, the D'Agostino reference does not disclose this.

In view of the amendment to the claims, it is believed that the rejection of claims 1-4, 6-12, and 14-17 as being unpatentable under 35 U.S.C. §102(b) as being anticipated by D'Agostino are now allowable. The rejection of these claims under 35 U.S.C. §102(b) should now be withdrawn.

Applicants respectfully request reconsideration of the rejection of claims 5 and 13 under 35 U.S.C. §103(a) as being unpatentable over D'Agostino. As indicated above, claims 1 and 9, the base independent claims from which claims 5 and 13 depend, have been shown to be allowable. Claims 5 and 13 are allowable for the same reasons. Further, as correctly stated by the Examiner, the D'Agostino reference does not disclose a

wireless connection. In view of the amendment to claims 1 and 9, the rejection of claims 5 and 13 under 35 U.S.C. §103(a) should be withdrawn.

Applicants request reconsideration of the rejection of claims 18-20 under 35 U.S.C. §103(a) as being unpatentable over Gifford, U.S. Patent No. 5,724,424 in view of D'Agostino. Claim 18, the base independent claim, has been amended to include the patentable feature of the controlling step having different levels of control. Neither Gifford nor D'Agostino alone or in combination teach such a method. Further, Applicants submit that there is no reason to combine these cited references in the manner suggested by the Examiner. In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 – Section 2143.03 for decisions pertinent to each of these criteria. In this case, none of these criteria have been met.

In rejecting claims under 35 U.S.C. §103, it is incumbent upon the Examiner to provide a reason why one having ordinary skill in the art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion, or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v.*

Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); *In re Sernaker*, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

It is imperative for the decision maker to place himself back in time to when the invention was unknown, i.e., without the applicant's disclosure at his side, and determine, in light of all the objective evidence bearing on the issue of obviousness, whether one having ordinary skill in the art would have found the claimed invention as a whole under 35 U.S.C. §103. *Panduit v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), *vacated* 475 U.S. 809, 229 USPQ 478 (1986), *aff'd on remand*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987).

In rejecting claim 18, the Examiner has apparently pieced together two prior art references, based upon having Applicants' disclosure before him, in concluding that it would have been obvious to combine the references. As the courts have frequently warned the use of "hindsight" in determining obviousness is improper. *In re Manurkar Patent Litigation*, 28 USPQ2d 1801 (N.D. Ill. 1993), is a case in which Judge Easterbrook stated that "decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex post analysis."

Further, Judge Easterbrook stated *Id.* at 1817: With hindsight the transistor is obvious; but devising the transistor was still a work of genius. An invention lies in a combination of elements that are themselves mundane. ... Unless the prior art itself

suggest the particular combination, it does not show that the actual invention was obvious or anticipated.

It is impermissible to use the inventor's disclosure as a "road map" for selecting and combining prior art disclosures. *Grain Processing Corp. v. American Maize-Products Corp.*, 5 USPQ2d 1788, 1792, (Fed. Cir. 1988); *American Medical Systems Inc. v. Medical Engineering Corp.*, 26 USPQ2d 1081, 1091 (E.D. Wis. 1992), *aff'd in part, rev'd in part & remanded*, 28 USPQ2d 1321 (Fed. Cir. 1993).

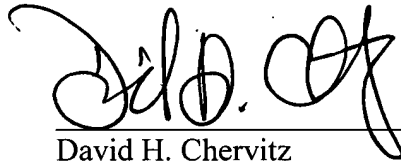
It is only with the Applicants' disclosure that the Examiner can conclude that it would have been obvious to combine Gifford with D'Agostino. As discussed previously, D'Agostino is a dedicated system. There is no reason to expand the system disclosed in D'Agostino. Further, Gifford only discloses a system for purchasing goods or information over a computer network. There is simply no reason or suggestion provided within the references themselves to combine the references in the manner suggested by the Examiner. Absent some teaching, suggestion, or inference in the prior art, the §103 rejection is improper.

Claims 19 and 20 depend from independent claim 18 that has been shown to be allowable. It is submitted that claims 19 and 20 are allowable for the same reasons. In view of the amendment to claim 18, the rejection of claims 18-20 under 35 U.S.C. §103(a) should be withdrawn.

Applicants request a one-month extension of time up to and including October 10, 2003, in order to respond to the Office Action dated June 10, 2003. Enclosed as payment for the requested one month extension is a check in the amount of \$55, the fee required for a one month extension of time under 37 CFR §1.17(a)(1).

Applicants submit that upon entry and review of the amended claims and consideration of the above remarks this application should be in condition for allowance. In the event that this application is for any reason not considered by the Examiner to be in form for allowance, Applicants' counsel requests the Examiner to telephone the undersigned before issuing a further action to discuss any objections the Examiner might have, thereby simplifying and expediting the examination and prosecution process.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "D.H. Chervitz", written over a horizontal line.

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Enclosure